

Appl. No. 09/632,774

Response Dated July 30, 2004

Response to Office Action dated July 22, 2004

REMARKS

No claims have been amended, no claims have been canceled, and no new claims have been added. Claims 1-25 are therefore pending.

Double Patenting

The Office Action objects to Claim 8 as being a substantial duplicate of claim 1 under 37 CFR 1.75. As this is a prospective objection that will not mature unless and until claims 1 and 8 are allowed in their present form, this objection will be addressed substantively only should claims 1 and 8 be allowed in their present form.

Claim Rejections - 35 USC § 102

The Office Action rejects claims 1-4, 7-18, 21, 24 and 25 under 35 USC § 102(e) as anticipated by Angles (US 5, 933,811). This rejection is respectfully traversed. MPEP § 706.02 (p. 700-21) states that under 35 USC § 102, a prior art "reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." The Office Action asserts that the limitations recited in the claims are taught by Angles. However, as set forth herein, the cited reference fails to teach either explicitly or impliedly every aspect of the invention recited in the claims. Therefore, each of the claims 1-4, 7-18, 21, 24 and 25 is patentably distinct from and is patentable over the cited reference.

Angles describes a system that, as discussed below, teaches away from the system recited in independent claims 1, 7, 11 and 15. Angles teaches a system that includes one or more content provider computers 14, one or more consumer computers 12, zero or more Internet providers 34, and one or more advertisement provider computers 18. The general functionality of Angles is that consumer computers 12 establish a communication link with the Internet using Internet provider 34. The consumer computers 12 then access the content provider computers 14 which transfer an electronic page 32 to the consumer computer 12. (Angles, col. 7, lines 55-60; col. 9, line 65 – col. 10, line 7; and Fig. 2) "The preferred electronic page 32 contains an embedded advertisement request 26" which the consumer computer receives and executes. (Angles, col. 7, lines 59-62) The advertisement provider computer 18 "sends a customized advertisement 30 directly to the consumer

Appl. No. 09/632,774

Response Dated July 30, 2004

Response to Office Action dated July 22, 2004

computer 12 to be incorporated into an electronic page 32 from the content provider computer 14.” (Angles, col. 15, lines 25-31) “The advertisement provider computer 18 ... maintains consumer information and generates customized advertisements 30.” (Angles, col. 13, lines 21-23)

However, claim 1 recites, among other limitations, “the online server transmitting sponsorship data to the client application, the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed and a resource locator associated with a click-through of the sponsorship label.” In contrast, Angles teaches away from this as Angles teaches an advertisement provider computer that sends advertisements to the consumer computer that are incorporated into a web page from the content provider computer. (Angles, col. 13, lines 21-23 and col. 15, lines 25-31) The Office Action fails to state which element of Angles teaches the sponsorship data recited in claim 1. We request that the Examiner explain which element of Angles the Examiner asserts teaches the sponsorship data recited in claim 1. If it is the advertisement request 26, the advertisement request is embedded in an electronic page and executed upon receipt by a consumer computer. (Angles, col. 7, lines 59-62) This in no way teaches “the online server transmitting sponsorship data to the client application, the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed and a resource locator associated with a click-through of the sponsorship label” recited in claim 1. As such, Angles fails to teach “the online server transmitting sponsorship data to the client application” as recited in claim 1.

In addition, claim 1 recites, among other limitations, “d) the client application displaying a sponsorship label on the client window, the sponsorship label comprising a hypertext link, wherein, when the user clicks through on the sponsorship label, the client application causes the local device to access the resource locator associated with a click-through of the sponsorship label.” The Office Action fails to direct us to any portion of Angles which teaches a “client application displaying a sponsorship label on the client window” as recited in claim 1. We recognize that Angles teaches optional Internet providers 34 (Angles, col. 9, lines 35-64), but we assert that Angles fails to teach the client application having the features recited in claim 1. As such, Angles fails to teach “the client application” as recited in claim 1.

Appl. No. 09/632,774
Response Dated July 30, 2004
Response to Office Action dated July 22, 2004

Further, claim 1 recites "when the user clicks through on the sponsorship label, the client application causes the local device to access the resource locator associated with a click-through of the sponsorship label." Angles teaches away from this limitation as Angles teaches that

When the consumer computer 12 receives the electronic page 32, it executes the embedded advertisement request 26. The embedded advertisement request 26 directs the consumer computer 12 to establish a communications link with the advertisement provider computer 18. Furthermore the embedded advertisement request 26 directs the advertisement provider computer 18 to execute a content provider script (not shown). The content provider script exists on the advertisement provider computer 18. (Angles, col. 7, line 61 – col. 8, line 2)

...

[T]he advertisement provider computer 18 selects an appropriate customized advertisement 30. The advertisement provider computer 18 then sends the customized advertisement 30 to the consumer computer 12. ... [T]he consumer computer 12 merges the electronic page 32 and customized advertisement 30. (Angles, col. 8, lines 13-19)

Importantly, Angles teaches that the consumer computer receives and executes an advertisement request and that the advertisement provider computer sends an advertisement to the consumer computer without receiving any user input, such as a click through. More simply, Angles teaches automatic selection and integration of advertisements in a web page requested by a user from a content provider, the advertisement provided by an advertisement provider. As such, there is no teaching in Angles of "when the user clicks through on the sponsorship label, the client application causes the local device to access the resource locator associated with a click-through of the sponsorship label" as recited in claim 1.

Similarly, claim 7 recites, among other limitations, "the online server transmitting sponsorship data to the client application, the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed." In contrast, Angles teaches away from this as Angles teaches an advertisement provider computer that sends advertisements to the consumer computer that are incorporated into a web page from the content

Appl. No. 09/632,774
Response Dated July 30, 2004
Response to Office Action dated July 22, 2004

provider computer. (Angles, col. 13, lines 21-23 and col. 15, lines 25-31) As such, Angles fails to teach "the online server transmitting sponsorship data to the client application" as recited in claim 7.

In addition, claim 7 recites, among other limitations, "e) the client application causing a sponsorship label to be displayed on the client window, the sponsorship label comprising a hypertext link associated with a resource locator to be accessed if a user clicks on the sponsorship label" as recited in claim 7. The Office Action fails to direct us to any portion of Angles which teaches a "client application causing a sponsorship label to be displayed on the client window" as recited in claim 7. We recognize that Angles teaches optional Internet providers 34 (Angles, col. 9, lines 35-64), but we assert that Angles fails to teach the client application having the features recited in claim 7. As such, Angles fails to teach "the client application" as recited in claim 7.

Moreover, Angles fails to teach a "sponsorship label comprising a hypertext link associated with a resource locator to be accessed if a user clicks on the sponsorship label." There is no teaching in Angles of this limitation as Angles teaches Angles teaches automatic selection and integration of advertisements in a web page requested by a user from a content provider, the advertisement provided by an advertisement provider. Importantly, Angles teaches that the consumer computer receives and executes an advertisement request and that the advertisement provider computer sends an advertisement to the consumer computer without receiving any user input, such as a click through. As such, Angles fails to teach "the client application causing a sponsorship label to be displayed" having the features recited in claim 7.

To the extent claims 11 and 15 have limitations similar to those discussed above with regard to claims 1 and 7, the above arguments also apply to claims 11 and 15. As claims 8 and 12 depend on claims 7 and 11, claims 8 and 12 are patentable over Angles by virtue of their dependency on claims 7 and 11.

With regard to claim 21, claim 21 recites, among other limitations:

e) the client application monitoring the user's interaction with the client window and assembling a usage history for the user based on the user's interaction, the usage history being descriptive of the subject matter of the data that the user accessed from the web server;

Appl. No. 09/632,774
Response Dated July 30, 2004
Response to Office Action dated July 22, 2004

The Examiner asserts that this limitation is taught at col. 16, lines 26-37 of Angles. However, this portion of Angles teaches that an advertisement provider computer monitors the number of advertisements viewed by consumers associated with a particular Internet provider. This portion of Angles does not mention a client application and does not teach a client application "monitoring the user's interaction with the client window and assembling a usage history for the user based on the user's interaction." We assert that Angles fails to teach a client application having these features.

Continuing with regard to claim 21, claim 21 further recites, among other limitations:

- g) the client application displaying an exit window on the output device of the local device, wherein the exit window includes an advertisement box associated with an exit window advertisement;
- h) the online server identifying an exit window advertisement for display to the user based upon the usage history, wherein a subject matter of the exit window advertisement is related to the subject matter described in the usage history;
- i) the online server transmitting instructions to the local device to display the exit window advertisement in the advertisement box of the exit window;
- j) the client application causing the exit window advertisement to be displayed in the advertisement box of the exit window.

The Office Action fails to address these limitations. We hereby request that the Examiner provide recitation to specific portions of Angles that the Examiner asserts recite limitations g), h), i) and j) of claim 21. We assert that Angles fails to teach a client application and an online server performing the actions recited in claim 21.

For all of the reasons asset forth above, Angles fails to teach each and everyone of the limitations recited in claims 1, 7, 8, 11, 12, 15 and 21. As such, these claims, and all claims dependent thereon are patentable over Angles.

Appl. No. 09/632,774
Response Dated July 30, 2004
Response to Office Action dated July 22, 2004

Claim Rejections - 35 USC § 103

The Office Action rejects claims 5, 19, 22, 23 and under 35 USC § 103(a) unpatentable over Angles. This rejection is respectfully traversed.

Claims 5, 19, 22, 23 are ultimately dependent on claims 1, 15 and 21. Claims 1, 15 and 21 are discussed above regarding the 35 USC § 102 rejections. For the same reasons claims 1, 15 and 21 are patentable over Angles as set forth above, by virtue of their dependency on these claims, claims 5, 19, 22, 23 are not rendered obvious by and are patentable over Angles.

The Office Action rejects claims 6 and 20 under as being unpatentable over Angles and Filepp (US 5,347,632) This rejection is respectfully traversed.

Claims 6 and 20 are ultimately dependent on claims 1 and 15. Claims 1 and 15 are discussed above regarding the 35 USC § 102 rejections. For the same reasons claims 1 and 15 are patentable over Angles as set forth above, by virtue of their dependency on these claims, claims 6 and 20 are not rendered obvious by and are patentable over Angles. Filepp fails to cure the deficiencies of claims 1 and 15 discussed above.

The Office Action states that Angles fails to disclose "a play list, comprising at least one ad object, each ad object comprising a resource locator for a given advertisement, a resource locator for a click-through associated with the given advertisement, and at least one display attribute for the given advertisement, the first play list further specifying an order in which the advertisements identified in the play list are to be displayed" as recited in claims 6 and 20. The Examiner states that Filepp teaches these limitations.

Filepp is directed to a method for storing data in an interactive computer network, which in Filepp's case was the Prodigy service. The portion of Filepp cited by the Examiner states that advertisements are presented from queues of advertisements constructed by an off-line business system and stored on a server. (Filepp, col. 9, lines 30-34) As such, Filepp fails to recite the limitations recited in claims 6 and 20. That is, as Filepp teaches queues of advertisement constructed by an off-line business system, Filepp fails to teach or suggest a play list comprising at least one ad object and "specifying an order in which the advertisements identified in the play list are to be

Appl. No. 09/632,774
Response Dated July 30, 2004
Response to Office Action dated July 22, 2004

displayed." Moreover, it is unclear how the queues of advertisements, off-line business system and the server correspond to the playlist, client window and the online server recited in claims 6 and 20.

As set forth above, the combination of Angles and Filepp fail to teach or suggest the limitations recited in claims 6 and 20. As such, claims 6 and 20 are not rendered obvious by and are patentable over the combination of Angles and Filepp.

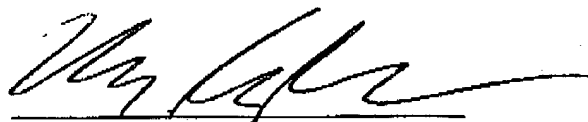
Conclusion

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for moving prosecution of this matter forward.

Respectfully submitted,

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